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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,771	08/07/2006	Anthony Jones	78104112-N18839	5972

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Intellectual Property Dept.
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EXAMINER	
MASHACK, MARK F	

ART UNIT	PAPER NUMBER
3773	

NOTIFICATION DATE	DELIVERY MODE
01/15/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket-ip@dewittross.com

Office Action Summary	Application No.	Applicant(s)	
	10/597,771	JONES ET AL.	
	Examiner	Art Unit	
	MARK MASHACK	3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 October 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,6-16 and 21-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,6-16 and 21-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to a communication dated 10/8/2009. Claims 1, 3, 6-16, and 21-25 are pending.

Response to Arguments

1. Applicant's arguments filed 10/8/2009 have been fully considered but they are not persuasive. Applicant argues that **Strecker** "does not have a 'means for coupling the elongate element and the delivery conduit *in situ*' as recited in claim 1". Examiner disagrees. Examiner contends that "coupling" only requires a loose association and delivery conduit **36** is coupled to elongate element **38** with element **40** since delivery counduit **36** and element **40** extend through a lumen of elongate element **38**.

Claim Objections

2. Claims 3, 6-9, 11-15 are objected to because of the following informalities: the claims depend on a cancelled claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 10** are rejected under 35 U.S.C. 102(b) as being anticipated by **Strecker (US 6,416,522)**.

Strecker discloses a delivery conduit **36**; an elongated element **38**; means for transforming axial advancement of the delivery conduit into movement of the distal end of the delivery conduit away from the longitudinal axis of the artery (Column 8, Lines 42-64). The elongate element **38** is stiffer than the end of the delivery conduit and is coupled to the delivery conduit **36** with element **40** (Column 8, Lines 42-64).

5. **Claims 21-25** are rejected under 35 U.S.C. 102(b) as being anticipated by **Kaji et al. ("Kaji" US 6,126,633)**.

Kaji discloses a system comprising: a delivery conduit **2** capable of delivering a staple; an elongate insertion element **1** being stiffer than at least the distal end of the delivery conduit; and having an insertion element joinder location **6** (Column 6, Lines 38-57) pivotally coupled to the delivery conduit at a delivery conduit joinder location **201, 202** which are held at a constant distance from each other (Column 2, Line 61, - Column 3, Line 10). Flexible tether **4** joins to delivery conduit and the insertion element.

6. **Claims 23 and 26** are rejected under 35 U.S.C. 102(e) as being anticipated by **Saadat et al. ("Saadat" US 2005/0251160)**.

Saadat discloses a delivery conduit **18** comprising an inner passage; an elongate insertion element **242** being stiffer than at least the distal end o the delivery conduit and

being joined to a joinder location **246** so that they are pivotally fixed together at the joinder location. A distal end of the elongated insertion element extends beyond a distal end of the delivery conduit (FIG 15).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 3, 6-8,** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Strecker** in view of **Kaji**.

Strecker discloses all of the claimed limitations except for being silent on the means for coupling the elongate element and the delivery conduit. However, **Kaji** teaches of a steerable surgical device with a similar means for transforming axial movement. And the elongate element **1** is coupled to the delivery conduit **2** with a knot **46** extending through apertures (proximal and distal end) of the elongate element **1** (FIG

10). Knots involving a figure eight are commonly known in the art (such as a double knot). **Strecker** discloses that a guide wire is used with a different embodiment (Column 8, Lines 35-38). It would have been obvious to use a guide wire with this embodiment to ensure proper positioning.

10. **Claim 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Strecker** in view of **Kaji** as applied to claim 6 above, and further in view of **Stevens-Wright et al ("Stevens-Wright" US 5,462,527)**.

Strecker and **Kaji** disclose all of the claimed limitations except for the knot being secured with an adhesive. However, **Stevens-Wright** teaches that it is commonly known in the art at the time of the invention to secure a knot with an adhesive (Column 6, Lines 15-17). Given the teachings of **Stevens-Wright**, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the knot of **Strecker** in view of **Kaji** by securing it with a knot in order to prevent it from coming undone.

11. **Claims 11-16** rejected under 35 U.S.C. 103(a) as being unpatentable over **Strecker** in view of **Kaji** as applied to claim 6 above, and further in view of **Weldon et al. ("Weldon" US 2005/0154401)**.

Strecker in view of **Kafi** disclose all of the claimed limitations except for the balloon. However, **Weldon** teaches a similar apparatus intended to fasten a graft to a vessel comprising a balloon **90** which secures the graft and assists the movement of the fasteners (Paragraph 37-39). All of the claimed elements were known in the prior art

and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Given the teachings of **Weldon**, it would have been obvious to provide a balloon to the device of **Strecker** in view of **Kaji** to ensure the proper placement of the fasteners and graft. The balloon can be partially inflated and still allow blood flow past. **Weldon** teaches that it is commonly known in the art at the time of the invention to use a sheath to deploy the graft **74**.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK MASHACK whose telephone number is (571)270-3861. The examiner can normally be reached on Monday-Thursday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Mashack/
Examiner, Art Unit 3773

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773